

12/28/01

01-02-02

PTO/SB/05 (03-01)

Approved for use through 10/31/2002. OMB 0651-0001
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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UTILITY PATENT APPLICATION TRANSMITTAL

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Attorney Docket No. 11321-P012USD4
First Inventor Richard E. Smalley
Title METHOD FOR FORMING A PATTERNED ARRAY OF
Express Mail Label No. EL 823 269 733 US

APPLICATION ELEMENTS

See MPEP chapter 600 concerning utility patent application contents.

- ☒ Fee Transmittal Form (e.g., PTO/SB/17)
(Submit an original and a duplicate for fee processing)
- ☒ Applicant claims small entity status.
See 37 CFR 1.27.
- ☒ Specification [Total Pages 98]
(preferred arrangement set forth below)
 - Descriptive title of the invention
 - Cross Reference to Related Applications
 - Statement Regarding Fed sponsored R & D
 - Reference to sequence listing, a table, or a computer program listing appendix
 - Background of the Invention
 - Brief Summary of the Invention
 - Brief Description of the Drawings (if filed)
 - Detailed Description
 - Claim(s)
 - Abstract of the Disclosure
- ☒ Drawing(s) (35 U.S.C. 113) [Total Sheets 21]
- Oath or Declaration [Total Pages]
 - ☐ Newly executed (original or copy)
 - ☒ Copy from a prior application (37 CFR 1.63 (d))
(for continuation/divisional with Box 18 completed)
 - ☐ **DELETION OF INVENTOR(S)**
Signed statement attached deleting inventor(s)
named in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b).
- ☐ Application Data Sheet. See 37 CFR 1.76

ADDRESS TO: Assistant Commissioner for Patents
Box Patent Application
Washington, DC 20231

- ☐ CD-ROM or CD-R in duplicate, large table or Computer Program (Appendix)
- Nucleotide and/or Amino Acid Sequence Submission (if applicable, all necessary)
 - ☐ Computer Readable Form (CRF)
 - Specification Sequence Listing on:
 - ☐ CD-ROM or CD-R (2 copies); or
 - ☐ paper
 - ☐ Statements verifying identity of above copies

ACCOMPANYING APPLICATION PARTS

- ☐ Assignment Papers (cover sheet & document(s))
- ☐ 37 CFR 3.73(b) Statement (when there is an assignee) ☐ Power of Attorney
- ☐ English Translation Document (if applicable)
- ☐ Information Disclosure Statement (IDS)/PTO-1449 ☐ Copies of IDS Citations
- ☒ Preliminary Amendment
- ☒ Return Receipt Postcard (MPEP 503) (Should be specifically itemized)
- ☐ Certified Copy of Priority Document(s) (if foreign priority is claimed)
- ☐ Nonpublication Request under 35 U.S.C. 122 (b)(2)(B)(i). Applicant must attach form PTO/SB/35 or its equivalent.
- ☒ Other: Prelim. Exam. Report; Two Substitute PQAs

18. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in a preliminary amendment, or in an Application Data Sheet under 37 CFR 1.76:

☐ Continuation ☒ Divisional ☐ Continuation-in-part (CIP)

of prior application No: 09, 380,545

Prior application information:

Examiner: S. Hendrickson

Group Art Unit: 1754

For CONTINUATION OR DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

19. CORRESPONDENCE ADDRESS

☐ Customer Number or Bar Code Label (Insert Customer No. or Attach bar code label here) or ☒ Correspondence address below

Name Ross Spencer Garsson
Address 100 Congress Avenue
Suite 800
City Austin State TX Zip Code 78701
Country USA Telephone 512-370-2870 Fax 512-370-2850

Name (Print/Type) Ross Spencer Garsson Registration No. (Attorney/Agent) 38,150
Signature [Signature] Date 12/28/2001

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.

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FEE TRANSMITTAL for FY 2002

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT (\$)

370.00

Complete if Known

| | |
|----------------------|--------------------|
| Application Number | Unassigned |
| Filing Date | December 28, 2001 |
| First Named Inventor | Richard E. Smalley |
| Examiner Name | Unassigned |
| Group Art Unit | Unassigned |
| Attorney Docket No. | 11321-P012USD4 |

METHOD OF PAYMENT

1. ☐ The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit
Account
Number

23-2426

Deposit
Account
Name

Winstead Sechrest & Minick

- ☒ Charge Any Additional Fee Required
Under 37 CFR 1.16 and 1.17

- ☒ Applicant claims small entity status.
See 37 CFR 1.27

2. ☒ Payment Enclosed:

- ☒ Check ☐ Credit card ☐ Money
Order ☐ Other

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Small Entity

| Fee Code | Fee (\$) | Fee Code | Fee (\$) | Fee Description | Fee Paid |
|----------|----------|----------|----------|------------------------|----------|
| 101 | 740 | 201 | 370 | Utility filing fee | 370.00 |
| 106 | 330 | 206 | 165 | Design filing fee | 0.00 |
| 107 | 510 | 207 | 255 | Plant filing fee | 0.00 |
| 108 | 740 | 208 | 370 | Reissue filing fee | 0.00 |
| 114 | 160 | 214 | 80 | Provisional filing fee | 0.00 |

SUBTOTAL (1) (\$)

370.00

2. EXTRA CLAIM FEES

| Total Claims | Extra Claims | Fee from below | Fee Paid |
|--------------------|--------------|----------------|----------|
| 10 | -20** = 0 | 9.00 | 0.00 |
| 2 | -3** = 0 | 42.00 | 0.00 |
| Multiple Dependent | | 280.00 | 0.00 |

Large Entity Small Entity

| Fee Code | Fee (\$) | Fee Code | Fee (\$) | Fee Description |
|----------|----------|----------|----------|--|
| 103 | 18 | 203 | 9 | Claims in excess of 20 |
| 102 | 84 | 202 | 42 | Independent claims in excess of 3 |
| 104 | 280 | 204 | 140 | Multiple dependent claim, if not paid |
| 109 | 84 | 209 | 42 | ** Reissue independent claims over original patent |
| 110 | 18 | 210 | 9 | ** Reissue claims in excess of 20 and over original patent |

SUBTOTAL (2)

(\$)

0.00

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

| Large Entity Fee Code | Large Entity Fee (\$) | Small Entity Fee Code | Small Entity Fee (\$) | Fee Description | Fee Paid |
|-----------------------|-----------------------|-----------------------|-----------------------|--|----------|
| 105 | 130 | 205 | 65 | Surcharge - late filing fee or oath | 0.00 |
| 127 | 50 | 227 | 25 | Surcharge - late provisional filing fee or cover sheet | 0.00 |
| 139 | 130 | 139 | 130 | Non-English specification | 0.00 |
| 147 | 2,520 | 147 | 2,520 | For filing a request for ex parte reexamination | 0.00 |
| 112 | 920* | 112 | 920* | Requesting publication of SIR prior to Examiner action | 0.00 |
| 113 | 1,840* | 113 | 1,840* | Requesting publication of SIR after Examiner action | 0.00 |
| 115 | 110 | 215 | 55 | Extension for reply within first month | 0.00 |
| 116 | 400 | 216 | 200 | Extension for reply within second month | 0.00 |
| 117 | 920 | 217 | 460 | Extension for reply within third month | 0.00 |
| 118 | 1,440 | 218 | 720 | Extension for reply within fourth month | 0.00 |
| 128 | 1,960 | 228 | 980 | Extension for reply within fifth month | 0.00 |
| 119 | 320 | 219 | 160 | Notice of Appeal | 0.00 |
| 120 | 320 | 220 | 160 | Filing a brief in support of an appeal | 0.00 |
| 121 | 280 | 221 | 140 | Request for oral hearing | 0.00 |
| 138 | 1,510 | 138 | 1,510 | Petition to institute a public use proceeding | 0.00 |
| 140 | 110 | 240 | 55 | Petition to revive - unavoidable | 0.00 |
| 141 | 1,280 | 241 | 640 | Petition to revive - unintentional | 0.00 |
| 142 | 1,280 | 242 | 640 | Utility issue fee (or reissue) | 0.00 |
| 143 | 460 | 243 | 230 | Design issue fee | 0.00 |
| 144 | 620 | 244 | 310 | Plant issue fee | 0.00 |
| 122 | 130 | 122 | 130 | Petitions to the Commissioner | 0.00 |
| 123 | 50 | 123 | 50 | Processing fee under 37 CFR 1.17(q) | 0.00 |
| 126 | 180 | 126 | 180 | Submission of Information Disclosure Stmt | 0.00 |
| 581 | 40 | 581 | 40 | Recording each patent assignment per property (times number of properties) | 0.00 |
| 146 | 740 | 246 | 370 | Filing a submission after final rejection (37 CFR § 1.129(a)) | 0.00 |
| 149 | 740 | 249 | 370 | For each additional invention to be examined (37 CFR § 1.129(b)) | 0.00 |
| 179 | 740 | 279 | 370 | Request for Continued Examination (RCE) | 0.00 |
| 169 | 900 | 169 | 900 | Request for expedited examination of a design application | 0.00 |
| Other fee (specify) | N/A | | | | 0.00 |

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)

0.00

SUBMITTED BY

Complete (if applicable)

Name (Print/Type)

Ross Spencer Garsson

Registration No.
(Attorney/Agent)

38,150

Telephone

512-370-2870

Signature

Date

12/28/2001

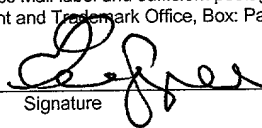
WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | | |
|--------------------------------|---|------------------------------------|--------------------------|
| In re Application of: | § | Serial No: | To Be Assigned |
| Richard E. Smalley et al. | § | | (division of application |
| | § | | Serial No. 09/380,545) |
| For: CARBON FIBERS FORMED FROM | § | | |
| SINGLE-WALL CARBON | § | Filed: HEREWITH | |
| NANOTUBES | § | | |
| | § | Group Art Unit: 1754 (anticipated) | |
| | § | | |
| Atty Dkt: 11321-P012USD4 | § | Prior Examiner: Stuart Henderson | |
| | § | 703.308.2539 | |

U.S. Patent and Trademark Office
BOX: PATENT APPLICATION
Washington, D.C. 20231

| "EXPRESS MAIL" MAILING LABEL | |
|--|--|
| Number: <u>EL 823 269 733 US</u> | |
| Pursuant to 37 C.F.R. § 1.10, I hereby certify that I am personally depositing this paper or fee with the United States Postal Service "Express Mail Post Office to Addressee" service on the date indicated above in a sealed envelope (a) having the above-numbered Express Mail label and sufficient postage affixed, and (b) addressed to the U.S. Patent and Trademark Office, Box: Patent Application, Washington, D.C. 20231. | |
| <u>December 28, 2001</u> | <u></u> |
| Date | Signature |
| | <u>Gracie Segovia</u> |
| | Printed Name |

REQUEST FOR FILING DIVISIONAL APPLICATION
UNDER 37 C.F.R. § 1.53(b)

This is a request for filing a divisional application under Rule 53(b) (37 C.F.R. § 1.53(b)) of co-pending prior application Serial No. 09/380,545, filed on September 3, 1999, entitled "CARBON FIBERS FORMED FROM SINGLE-WALL CARBON NANOTUBES," which is the 35 U.S.C. § 371 national application of International Application Number PCT/US98/04513 filed on March 6, 1998, which designated the United States, claiming priority to: provisional U.S. patent application Serial Number 60/067,325, filed on December 5, 1997; provisional U.S. patent application Serial Number 60/064,531, filed on November 5, 1997; provisional U.S. patent application Serial Number 60/063,675, filed on October 29, 1997; provisional U.S. patent application Serial Number 60/055,037, filed on August 8, 1997; provisional U.S. patent application Serial Number 60/047,854, filed on May 29, 1997; and provisional U.S. patent application Serial Number 60/040,152, filed on March 7, 1997. Each of the foregoing

IN RE: APPLICATION OF SMALLEY ET AL.
REQUEST FOR FILING DIVISIONAL APPLICATION UNDER 37 C.F.R. § 1.53(b)

applications is commonly assigned to the assignee of the present invention and is hereby incorporated herein by reference in its entirety.

1. Enclosed is a copy of the co-pending prior application Serial No. 09/380,545, filed on September 3, 1999, entitled "CARBON FIBERS FORMED FROM SINGLE-WALL CARBON NANOTUBES," which is the 35 U.S.C. § 371 national application of International Application Number PCT/US98/04513 filed on March 6, 1998, which designated the United States, claiming priority to: provisional U.S. patent application Serial Number 60/067,325, filed on December 5, 1997; provisional U.S. patent application Serial Number 60/064,531, filed on November 5, 1997; provisional U.S. patent application Serial Number 60/063,675, filed on October 29, 1997; provisional U.S. patent application Serial Number 60/055,037, filed on August 8, 1997; provisional U.S. patent application Serial Number 60/047,854, filed on May 29, 1997; and provisional U.S. patent application Serial Number 60/040,152, filed on March 7, 1997. The undersigned hereby incorporates co-pending prior patent application Serial No. 09/380,545, International Application Number PCT/US98/04513, provisional application Serial No. 60/067,325, provisional application Serial No. 60/064,531, provisional application Serial No. 60/063,675, provisional application Serial No. 60/055,037, provisional application Serial No. 60/047,854, and provisional application Serial No. 60/040,152, herein by reference and verifies that the enclosed papers are a copy of the co-pending prior patent application Serial No. 09/380,545 as originally filed and identified above, that no amendments (if any) referred to in the declaration filed to complete the prior application introduced new matter therein, and further that this statement was made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statement may jeopardize the validity of the application or any patent issuing thereon.

IN RE: APPLICATION OF SMALLEY ET AL.
REQUEST FOR FILING DIVISIONAL APPLICATION UNDER 37 C.F.R. § 1.53(b)

- (a) ☒ The inventorship is the same as co-pending prior patent application Serial No. 09/380,545.
- (b) ☐ Deletion of inventor(s). Signed statement attached deleting inventor(s) named in the prior application, see 37 C.F.R. § 1.63(d)(2) and 1.33(b).
- (c) ☐ Priority of foreign patent application number _____, filed _____ in _____ is claimed under 35 U.S.C. § 119(a)-(e). The certified copy:
☐ is enclosed.
☐ has been filed in the prior Application Serial No. _____

- ☐ 2. The Assistant Commissioner is requested to grant Applicants a filing date in accordance with Rule 1.53, and supply Applicants with a Notice of Missing Parts in due course, in accordance with the provisions of Rule 1.53(f).
- ☒ 3. Enclosed is a check in the amount of \$370.00 to cover the filing fee as calculated below and the fee for any new claims added in the Preliminary Amendment referred to in Part No. 9 below.

CLAIMS FOLLOWING ENTRY OF PRELIMINARY AMENDMENT

| FOR | NUMBER FILED | NUMBER EXTRA | RATE | FEE |
|-----------------------------------|-----------------|-----------------|--------|-----------------|
| Basic Fee ----- | | | | \$370.00 |
| Total Claims | 10 - 20 = | 0 × | \$9 = | \$00.00 |
| Independent Claims | 2 - 3 = | 0 × | \$42 = | \$00.00 |
| Multiple Dependent Claim(s) ----- | | | | \$00.00 |
| TOTAL FILING FEES: | | | | \$370.00 |

IN RE: APPLICATION OF SMALLEY ET AL.
REQUEST FOR FILING DIVISIONAL APPLICATION UNDER 37 C.F.R. § 1.53(b)

- ☒ 4. Applicant is entitled to Small Entity Status for this application.
- ☐ (a) A small entity statement is enclosed.
- ☒ (b) A small entity statement was filed in the prior nonprovisional application and such status is still proper and desired.
- ☒ 5. If the check is missing or insufficient, the Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required for any reason relating to this application, or credit any overpayment, to Winstead Sechrest & Minick Deposit Account No. 23-2426 referencing 11321-P012USD4.
- ☐ 6. Enclosed is a copy of the current Power of Attorney in the prior application.
- ☒ 7. Address all future communications to:
- Ross Spencer Garsson
WINSTEAD SECHREST & MINICK P.C.
100 Congress Avenue
Suite 800
Austin, Texas 78701
(512) 370-2870 (voice)
(512) 370-2850 (fax)
- ☒ 8. The prior application is presently assigned to William Marsh Rice University.
- ☒ 9. Enclosed is a Preliminary Amendment. Any additional fees incurred because of the Preliminary Amendment are included in the check at No. 3 above and said fee has been calculated after calculation of claims and after amendment of claims by the Preliminary Amendment.
- ☒ 10. Cancel in this application claims 1-33 and 36-162 of the prior application before calculating the filing fee.

IN RE: APPLICATION OF SMALLEY ET AL.
REQUEST FOR FILING DIVISIONAL APPLICATION UNDER 37 C.F.R. § 1.53(b)

- ☒ 11. This application is a division of co-pending prior application Serial No. 09/380,545, filed on September 3, 1999, entitled "CARBON FIBERS FORMED FROM SINGLE-WALL CARBON NANOTUBES," which is the 35 U.S.C. § 371 national application of International Application Number PCT/US98/04513 filed on March 6, 1998, which designated the United States, claiming priority to: provisional U.S. patent application Serial Number 60/067,325, filed on December 5, 1997; provisional U.S. patent application Serial Number 60/064,531, filed on November 5, 1997; provisional U.S. patent application Serial Number 60/063,675, filed on October 29, 1997; provisional U.S. patent application Serial Number 60/055,037, filed on August 8, 1997; provisional U.S. patent application Serial Number 60/047,854, filed on May 29, 1997; and provisional U.S. patent application Serial Number 60/040,152, filed on March 7, 1997. Each of the foregoing applications is commonly assigned to the assignee of the present invention and is hereby incorporated herein by reference in its entirety.

This application discloses subject matter related to the subject matter of U.S. patent application Serial Number 10/000,746, filed on November 30, 2001, in the name of Daniel T. Colbert et al., entitled "MACROSCOPICALLY MANIPULABLE NANOSCALE DEVICES MADE FROM NANOTUBE ASSEMBLIES," which application is commonly assigned to the assignee of the present invention.

- ☐ 12. Enclosed are formal drawings.
- ☐ 13. An Information Disclosure Statement (IDS) is enclosed.
- ☐ (a) PTO/SB/08A.
- ☐ (b) Copies of IDS citations.
- ☐ 14. Transfer the sequence information, including the computer readable form previously submitted in the parent application, Serial No. _____, filed _____, for use in this

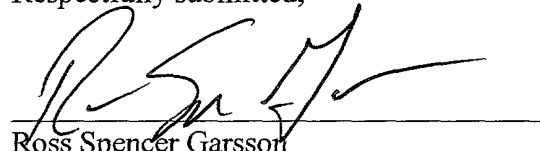
IN RE: APPLICATION OF SMALLEY ET AL.
REQUEST FOR FILING DIVISIONAL APPLICATION UNDER 37 C.F.R. § 1.53(b)

application. Under 37 C.F.R. § 1.821(e), Applicant states that the paper copy of the sequence listing in this application is identical to the computer readable copy in parent application Serial No. filed . Under 37 C.F.R. § 1.821(f), Applicant also states that the information recorded in computer readable form is identical to the written sequence listing.

- ☐ 15. Other: _____.
- ☒ 16. Return Receipt Postcard (should be specifically itemized).

Date: December 28, 2001

Respectfully submitted,



Ross Spencer Garsson
Reg. No. 38,150
Winstead Sechrest & Minick P.C.
100 Congress Avenue
Suite 800
Austin, Texas 78701
(512) 370-2870 (voice)
(512) 370-2850 (fax)

ATTORNEYS FOR ASSIGNEE

AUSTIN_1\180587\1
12/28/2001 - 11321-P012USD4